



**UNITED STATES DEPARTMENT OF COMMERCE**  
**United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*NBD*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/416,860 10/13/99 MONTGOMERY

D 16650004US03

027194 IM31/0803  
HOWREY SIMON ARNOLD & WHITE, LLP  
BOX 34  
301 RAVENSWOOD AVE.  
MENLO PARK CA 94025

EXAMINER

SMITH HICKS, F

ART UNIT	PAPER NUMBER
----------	--------------

1741

//

DATE MAILED:

08/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/416,860

Applicant(s)

MONTGOMERY, Donald D.

Examiner

Erica D. Smith-Hicks

Art Unit

1741

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12-23 and 25-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-23 and 25-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

This Action is in response to Applicant's Amendment filed April 24, 2001. The text of those sections of Title 35 U.S.C. not found in this action can be found in the previous Action mailed October 24, 2000.

#### ***Claim Rejections - 35 USC § 102***

1. Claims 1, 6-9, 11-15 and 47 were rejected under 35 U.S.C. 102(a) as anticipated by SOUTHERN, US 5,667,667. The rejection has been withdrawn in view of Applicant's arguments.

#### ***Claim Rejections - 35 USC § 102***

2. Claims 1-9 and 11-51 were rejected under 35 U.S.C. 103(a) as being unpatentable over HELER et al. US 5,929,208 in view of SOUTHERN, US 5,667,667. The rejection has been withdrawn in view of Applicant's arguments.

#### ***Double Patenting***

3. The double patenting rejection of claims 1-51 over claims 1-49 of Applicant's copending application serial number 09/003075 now US 6,093,302 issued July 25, 2000 and co-pending US Application serial number 09/394138 still pending has been maintained.

***Terminal Disclaimer***

4. Examples of acceptable language for making the disclaimer of the terminal portion of any patent granted on the subject application follow:

I. If a Provisional Obviousness-Type Double Patenting Rejection Over A Pending Application was made, use:

Petitioner hereby disclaims, except as provided below, the terminal part of any patent granted on the instant application, which would extend beyond the expiration date of any patent granted on Application No. \_\_\_\_/\_\_\_\_\_, filed on \_\_\_\_\_, as shortened by any terminal disclaimer. Petitioner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the above-listed application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors, or assigns.

II. If an Obviousness-Type Double Patenting Rejection Over A Prior Patent was made, use:

Petitioner hereby disclaims, except as provided below, the terminal part of any patent granted on the instant application, which would extend beyond the expiration date of Patent No. \_\_\_\_\_, as presently shortened by any terminal disclaimer. Petitioner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the above listed patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors, or assigns.

5. Applicant is encouraged to file a terminal disclaimer to place the claims in condition for allowance over Applicant's parent US Application serial number 09/003075 now US 6,093,302 issued July 25, 2000 and co-pending US Application serial number 09/394138 still pending.

***Allowable Subject Matter***

6. Claims 1-9, 12-23, and 25-51 will be allowable over the teachings of Applicant's parent and co-pending Applications as indicated above, upon the filing of a terminal disclaimer.

7. The following is an examiner's statement of reasons for the indication of allowable subject matter: The Examiner is relying upon Applicant's arguments presented in Paper No. 10 for the allowability of the instant claims. The Examiner particularly agrees with Applicant's argument that HELLER et al. do not teach electrochemical combinatorial synthesis, but rather electrophoretic placement of material on a substrate array. Neither SOUTHERN nor HELLER et al. teach or suggest the limitations of the instant claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 1741

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica D. Smith-Hicks whose telephone number is 703/ 305-7645. The examiner can normally be reached on Mon.-Tues. 7:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathryn Gorgos can be reached on 703/ 308-3328. The fax phone numbers for the organization where this application or proceeding is assigned are 703/ 872-9311 for regular communications and 703/ 872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/ 308-0661.

Erica D. Smith-Hicks  
Examiner  
Art Unit 1741

ESH  
August 2, 2001

DONALD R. VALENTINE  
PRIMARY EXAMINER  
GROUP 1100

1741